

**REMARKS**

**I. Status of the Claims**

Claims 24, 27-49 and 51-76 are pending in this application. Claims 27-33, 38-48, 52-73, and 76 stand as withdrawn from consideration by the Examiner. Claims 24, 34-37, 49, 51, 74 and 75 are pending and under consideration. Claim 51 has been amended herein so as to depend from a pending claim. No other claims have been amended herein. Support for the amendment to claim 51 can be found in the specification as originally filed. Thus, no issue of new matter is raised by this amendment.

**II. Claim Objections**

The Examiner has objected to claim 51 as depending from a cancelled claim. In response, Applicants have amended claim 51 to depend from claim 49, which is currently pending. Thus, Applicants respectfully request that this objection be withdrawn.

**III. Rejection Under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 24, 34-37, 49, and 74-75 under 35 U.S.C. § 102(b) as being anticipated by Birtwistle et al. (U.S. Patent No. 5,139,781) (Birtwistle) for the reasons disclosed on pages two through four of the Office Action. To establish a rejection under 35 U.S.C § 102(b), the Examiner must demonstrate that the reference teaches each and every claim limitation. See M.P.E.P § 2141. This the Examiner has not done.

In rejecting claims 24, 34-37, 49, and 74-75 under § 102(b), the Examiner relies on example 9 of Birtwistle as the basis of the anticipation rejection. Office Action

triethanolamine mono-(ethyleneglycol-mono-n-decyl ether) phosphate (an anionic surfactant, 10% by weight), triethanolammonium di-(ethyleneglycol-mono-n-octadecenyl ether) phosphate (an anionic surfactant, 8% by weight), cocoamphodipropionate (an amphoteric surfactant, 9% by weight), and ethylene glycol monostearate (a non-ionic surfactant and water insoluble ester, 1.5% by weight). Birtwistle, column 15, lines 55-69. According to the Examiner, this example anticipates claims 24, 34-37, 49, and 74-75. Office Action at pages 3-4. Applicants respectfully disagree for the following reasons.

**A. Claims 24, 34, their dependants, and claims 74-75**

In rejecting claims 24, 34, their dependants, and claims 74-75, the Examiner appears to be asserting that ethylene glycol monostearate is equivalent to the at least one water insoluble mono-carboxylic acid ester recited in these claims. Applicants disagree.

Ethylene glycol monostearate is a monoester, and is therefore only capable of reading on options 1, 3, 4, 7, 9 and 10 recited by claims 24, 34, 74 and 75 for the water insoluble carboxylic acid ester. However, example 9 of Birtwistle does not read on any of the above recited options, as will be shown in detail below. Key differences between the as claimed invention and example 9 of Birtwistle are highlighted below in bold.

Option 1 of claims 24, 34, 74 and 75 includes esters derived from reacting monocarboxylic acids with linear/branched saturated/unsaturated **mono** alcohols. Ethylene glycol monostearate however, is derived from the reaction of a monocarboxylic acid (stearic acid) with a **diol** (ethylene glycol,  $\text{OHCH}_2\text{CH}_2\text{OH}$ ). Thus, ethylene glycol

monostearate does not read on option 1 of claims 24, 34, 74 and 75 as asserted by the Examiner.

Option 3 of claims 24, 34, 74 and 75 includes mono-, di-, and triesters derived from reacting saturated and unsaturated linear and branched **di and tri-carboxylic acids** with saturated and unsaturated, linear and branched dialcohols. Ethylene glycol monostearate however, is derived from the reaction of a **monocarboxylic acid** (stearic acid) with a linear saturated diol (ethylene glycol). Thus, ethylene glycol monostearate does not read on option 3 of claims 24, 34, 74 and 75, as asserted by the Examiner.

Option 4 of claims 24, 23, 74 and 75 includes monoesters derived from reacting saturated and unsaturated, linear and branched monocarboxylic acids with saturated and unsaturated, linear and branched **C<sub>3</sub>-C<sub>49</sub> dialcohols**. Ethylene glycol monostearate however, is derived from the reaction of a monocarboxylic acid with a **C<sub>2</sub> dialcohol** (ethylene glycol). Thus, ethylene glycol monostearate does not read on option 4 of claims 24, 34, 74 and 75, as asserted by the Examiner.

Options 7, 9, and 10 of claims 24, 34, 74 and 75 include monoesters derived from reacting various carboxylic acids with various **trialcohols**. Ethylene glycol monostearate however, is derived from the reaction of a monocarboxylic acid with a **diol**. Thus, ethylene glycol monostearate does not read on options 7, 9, and 10 of claims 24, 34, 74 and 75, as asserted by the Examiner.

Based on at least these differences, Birtwistle fails to teach each and every element recited by claims 24, 24, 74 and 75, and all claims dependent thereon. Accordingly, the rejection of these claims under 35 U.S.C. §102(b) is in error, and should be withdrawn.

**B. Claim 49 and its Dependents**

In rejecting claim 49 and its dependents as anticipated by Birtwistle, the Examiner asserts that ethylene glycol monostearate is equivalent to at least one of the specific water insoluble monocarboxylic acid esters recited by these claims. Office Action at page 4. Applicants respectfully disagree for at least the following reason.

Claim 49 includes **diethylene** glycol monostearate, whereas example 9 of Birtwistle include ethylene glycol monostearate. Ethylene glycol monostearate is equivalent to **monoethylene** glycol monostearate. Quite simply, **diethylene** glycol monostearate is not the same as **monoethylene** glycol monostearate.

Thus, Birtwistle fails to teach each and every element recited by claim 49 and its dependents. Therefore, the rejection of these claims under 35 U.S.C. § 102(b) is in error, and should be withdrawn.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 7, 2005

By:



Mark D. Sweet  
Reg. No. 41,469